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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/844,976	04/26/2001	Erin H. Sibley	PD-200352A	1644

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EXAMINER

USTARIS, JOSEPH G

ART UNIT	PAPER NUMBER
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2617

DATE MAILED: 10/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/844,976

Applicant(s)

SIBLEY, ERIN H.

Examiner

Joseph G. Ustaris

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 13-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/10/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment dated 26 July 2005 in application 09/844,976. Claims 1-17 are pending. Claims 1 and 9 are amended. Applicant affirms the election of claims 1-12. Claims 13-17 are withdrawn from consideration.

Terminal Disclaimer

2. The terminal disclaimer filed on 26 July 2005 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of any patent granted on Application Number 09/844,923 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Accordingly, the obviousness-type double patenting provisional rejection is now withdrawn.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on 10 June 2005 was filed after the mailing date of the Non-final Office Action on 19 May 2005. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 and 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks et al. (US006160989A) in view of Kim (US006556248B1).

Regarding claim 1, Hendricks et al. (Hendricks) discloses a "system of distributing electronic content" over various transmission media, e.g. CATV system (See Fig. 1). The system includes a "satellite" (See Fig. 1), "a network operations center uplinking electronic content to said satellite" (See Fig. 1, 202), "a terrestrial over-the-air digital broadcast center receiving said electronic content from said satellite" (See Fig. 1, 208; column 7 lines 11-34), and a "user appliance receiving said electronic content" (See Fig. 1, 220). Furthermore, after receiving the "electronic content", the system "generates digital over-the-air electronic content" in order to successfully deliver the digital content to the user's site (See Fig. 3; column 7 lines 35-65 and column 10 lines 1-51). However, Hendricks, after receiving the "electronic content", does not disclose using the "vertical blanking interval (VBI)" to deliver the "digital over-the-air electronic content".

Hendricks discloses that analog signals are used between the headend and user terminals (See Fig. 3). Kim discloses a general TV broadcast system and TV receiving apparatus. The system is able to load HTML image and audio data or "digital electronic

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content" within the VBI or "during a VBI of an analog broadcast signal" (See Figs. 1 and 3; column 5 lines 28-53). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the cable headend disclosed by Hendricks to be able to transmit some of the data or "electronic content" within the VBI of an "analog broadcast signal", as taught by Kim, in order to efficiently use the bandwidth available between the headend and user terminals thereby increasing the efficiency of the overall system.

Regarding claim 2, as disclosed in claim 1 rejection, Hendricks discloses a satellite (stratospheric platform) communicates (coupled) with the cable headend (over the air broadcast center).

Regarding claim 3, Hendricks discloses that one of the transmission media can be a cellular network (See Hendricks column 7 lines 29-34), which inherently includes a "cell tower".

Regarding claim 4, Hendricks in view of Kim discloses different types of transmission media (e.g. cellular networks) to the home and suggests that similar technology can be used interchangeably (column 7, lines 29-34). However, Hendricks does not explicitly disclose a TV broadcast tower.

Official Notice is taken that it is well known in the art that TV broadcast towers are used as a transmission scheme. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the system disclosed by Hendricks in view of Kim to include a TV broadcast tower in order to

provide more versatility, options of transmission, and robustness of transmission in case of malfunction by one scheme.

Regarding claims 5 and 6, Hendricks discloses both digital audio and video (See column 5 lines 6-16).

Regarding claim 7, the set top terminals or "user appliance" is "fixed" (See Hendricks Fig. 1).

Claim 9 contains the limitations of claim 1 (wherein the system performs the method) and is analyzed as previously discussed with respect to that claim.

Claim 10 contains the limitations of claims 2 and 9 and is analyzed as previously discussed with respect to those claims.

Claim 11 contains the limitations of claims 3 and 9 and is analyzed as previously discussed with respect to those claims.

Claim 12 contains the limitations of claims 4 and 9 and is analyzed as previously discussed with respect to those claims.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks et al. (US006160989A) in view of Kim (US006556248B1) as applied to claims 1-7 and 9-12 above, and further in view of Owa et al. (US006711379B1).

Hendricks in view of Kim does not disclose that the "user appliance is mobile".

Owa et al. (Owa) discloses a digital broadcasting system and terminal. Owa discloses mobile receiving terminals that can receive broadcasts from various sources (See Figs. 1, 23, and 24; column 7 lines 21-35). Therefore, it would have been obvious

to one with ordinary skill in the art at the time the invention was made to modify the system disclosed by Hendricks in view of Kim to include mobile receiving terminals or "mobile user appliance", as taught by Owa, in order to expand the capabilities of the system thereby making the system more convenient for the user by enabling the user to roam freely with the mobile terminal.

Response to Arguments

5. Applicant's arguments filed 26 July 2005 have been fully considered but they are not persuasive.

Applicant argues with respect to claims 1 and 9 that Hendricks or Kim does not disclose or suggest a terrestrial over-the-air broadcast center. Applicant extends these arguments to the dependent claims. However, Hendricks does disclose a cable headend that resides on earth and transmits signals to the users that resides on the earth (See Hendricks Fig. 1) or terrestrial over-the-air broadcast center. Furthermore, Hendricks discloses that the system can use other delivery systems to transport services/content to the user, e.g. cellular networks (See Hendricks column 7 lines 29-34). It is well known that cellular networks wirelessly transmit services/content via radio transmissions through the air or "over-the-air".

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

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In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). It is well known in the art to utilize the VBI to transport additional data as disclosed by Kim. Applicant states that Hendricks is a generic communication system that only conventional broadcasting without extra content is set forth. However, the system disclosed by Hendricks is capable of providing more than just conventional broadcasting as suggested by Figs. 8A-8C. Furthermore, Kim discloses a system that delivers supplemental/additional content using the VBI that would result in efficient usage of available bandwidth thereby providing high volume data transfers. This technique disclosed by Kim would efficiently use the bandwidth available between the headend and user terminals thereby increasing the efficiency of the overall system.

Applicant is reminded that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph G. Ustaris whose telephone number is 571-272-7383. The examiner can normally be reached on M-F 7:30-5PM; Alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher S. Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JGU
October 6, 2005



VIVEK SRIVASTAVA
PRIMARY EXAMINER